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| ART UNIT | PAPER NUMBER |
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| 2772 | 34 |

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

#35
2 of 3

500.26967R00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant(s): K. KATSURA, et al.
Serial No.: 07/985,141
Filing Date: December 3, 1992
For: GRAPHIC PROCESSING APPARATUS UTILIZING
IMPROVED DATA TRANSFER TO REDUCE MEMORY SIZE
Group: 2772
Examiner: M. Zimmerman

REPLY BRIEF

Assistant Commissioner
for Patents
Washington, D.C. 20231

May 24, 1999

Sir:

This Reply Brief is being filed in response to the
Examiner's Answer dated March 24, 1999.

NEW POINT OF ARGUMENTS

1. The Examiner contends that the Supplemental Reissue Declaration is defective being that it fails to particularly specify the errors relied upon as required under 37 CFR §1.175(a)(3) and (5).

2. The Examiner contends that Graciotti teaches a memory controller as recited in the claims.

ARGUMENTS

With respect to the first new point of argument wherein the Examiner contends that the Supplemental Reissue Declaration is defective being that it fails to particularly specify the errors relied upon as required under 37 CFR §1.175(a)(3) and (5) the following is provided.

Again, as stated in the Appeal Brief Appellants' fail to

understand why the Examiner has not fully read or made any effort to understand the language as set forth in the Supplemental Reissue Declaration and the practice as now set forth under 37 CFR §1.175 and chooses to force Appellants' to appeal such a minor issue to the Board. Had the Examiner done so the issue would have been rendered moot.

In the Examiner's Answer, it is quite apparent that the Examiner has not consulted the current practice under 37 CFR §1.175. The Examiner sets forth in the Examiner's Answer the alleged contents of 37 CFR §1.175(a). Upon reviewing the alleged contents of 37 CFR §1.175(a) as set forth in the Examiner's Answer it is clear that the Examiner has not read nor is he familiar with the current embodiment of 37 CFR §1.175(a). The alleges content of 37 CFR §1.175(a) set forth in the Examiner's Answer has long since been replaced by new language. A copy of the current embodiment of 37 CFR §1.175 is attached for the Examiner's reference. Upon review of the attached copy of 37 CFR §1.175(a) the Examiner will note that the current embodiment of 37 CFR §1.175 does not include alleged sections 37 CFR §1.175(a)(3) and 37 CFR §1.175(a)(5). The Examiner is urged to update his records with the attached copy of 37 CFR §1.175.

The Examiner should also read and understand the contents of MPEP 1444 which describe how reissue declarations are to be reviewed in light of the contents of the current embodiment of 37 CFR §1.175.

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attached for the Examiner's reference. The Examiner is urged to update his records with the attached copy of MPEP 1444. The Examiner is strongly urged to review these materials and provide an indication as to whether the September 28, 1998 Supplemental Reissue Declaration complies with the current embodiment of 37 CFR §1.175 and MPEP 1444. An indication of such would not only expedite this Appeal but reduce the number of issues to be considered by the Board.

With respect to the second new point of argument in which the Examiner contends that Graciotti teaches a memory controller as recited in the claims, the following is provided.

Appellants' submit that Graciotti does not teach or suggest a memory controller as recited in the claims being that the claims as argued in the Appeal Brief includes several elements and performs several functions which are not taught or suggested by Graciotti nor any of the references of record whether taken individually or in combination with Graciotti. Particularly, Appellants' invention is directed to a graphic processing apparatus having a memory controller connected between a data processor and memory and the memory controller itself. The memory controller as recited in the claims and as disclosed in the specification and illustrated in the drawings performs control operations with respect to a memory to allow a data processor to access the memory. Graciotti merely teaches a bus converter circuit intended to be connected between a microprocessor and a peripheral which as discussed in Graciotti can be software or a device such as a floppy disk controller. Although Graciotti refers to memory

expansion, it is clear to one of ordinary skill in the art that the alleged memory expansion is provided by a device external of the microprocessor system and is merely connected to the microprocessor by the bus. There is no teaching or suggestion in Graciotti that the bus converter as taught therein controls the operation of a memory as clearly recited in the claims, and as disclosed in the specification and illustrated drawings. In the drawings, such as that illustrated in Fig. 1, the memory is controlled using a row address strobe (RAS) signal, CS signal, DE signal, WE signal, etc., one of ordinary skill in the art would readily recognize that such signals are produced by a memory controller in order to control, for example, semiconductor memory. Such signals for controlling the operation of memory are clearly not taught or suggested by Graciotti as being supplied by the bus converter. Thus, the bus converter taught by Graciotti is not intended to operate and control memory as in the memory controller of Appellants' invention.

One of ordinary skill in the art upon reviewing the specification and drawings of Appellants' application would clearly be apprised that Appellants' invention is directed to a memory controller which controls the operation of, for example, semiconductor memory. Such is clearly not taught or suggested by Graciotti nor any of the other references of record whether taken individually or in combination with each other.

SUMMARY

Based on the above, Appellants submit that the Examiner's final rejection of the claims under 35 USC §251 as being based

on an alleged defective Reissue Declaration and under 35 USC §103 as being unpatentable over Graciotti, Tanenaka and Pinkham are not properly founded in law and respectfully request that the Board reverse the Examiner's final rejection.

To the extent necessary, applicants petition for an extension of time under 37 C.F.R. section 1.136. Please charge any shortage in the fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 01-2135 (Case No. 500.26967R00) and please credit any excess fees to such Deposit Account.

Respectfully submitted,



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§ 1.175

§ 1.175 Reissue oath or declaration.

(a) The reissue oath or declaration in addition to complying with the requirements of § 1.63, must also state that:

(1) The applicant believes the original patent to be wholly or partly inoperative or invalid by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than the patentee had the right to claim in the patent, stating at least one error being relied upon as the basis for reissue; and

(2) All errors being corrected in the reissue application up to the time of filing of the oath or declaration under this paragraph arose without any deceptive intention on the part of the applicant.

(b)(1) For any error corrected, which is not covered by the oath or declaration submitted under paragraph (a) of this section, applicant must submit a supplemental oath or declaration stating that every such error arose without any deceptive intention on the part of the applicant. Any supplemental oath or declaration required by this paragraph must be submitted before allowance and may be submitted:

(i) With any amendment prior to allowance; or

(ii) In order to overcome a rejection under 35 U.S.C. 251 made by the examiner where it is indicated that the submission of a supplemental oath or declaration as required by this paragraph will overcome the rejection.

(2) For any error sought to be corrected after allowance, a supplemental oath or declaration must accompany the requested correction stating that the error(s) to be corrected arose without any deceptive intention on the part of the applicant.

(c) Having once stated an error upon which the reissue is based, as set forth in paragraph (a)(1), unless all errors previously stated in the oath or declaration are no longer being corrected, a subsequent oath or declaration under paragraph (b) of this section need not specifically identify any other error or errors being corrected.

(d) The oath or declaration required by paragraph (a) of this section may be

submitted under the provisions of § 1.53(f).

[62 FR 53196, Oct. 10, 1997]

§ 1.176 Examination of reissue.

An original claim, if re-presented in the reissue application, is subject to re-examination, and the entire application will be examined in the same manner as original applications, subject to the rules relating thereto, excepting that division will not be required. Applications for reissue will be acted on by the examiner in advance of other applications, but not sooner than two months after announcement of the filing of the reissue application has appeared in the *Official Gazette*.

[42 FR 6595, Jan. 23, 1977]

§ 1.177 Reissue in divisions.

The Commissioner may, in his or her discretion, cause several patents to be issued for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for each division. Each division of a reissue constitutes the subject of a separate specification descriptive of the part or parts of the invention claimed in such division; and the drawing may represent only such part or parts, subject to the provisions of §§ 1.83 and 1.84. On filing divisional reissue applications, they shall be referred to the Commissioner. Unless otherwise ordered by the Commissioner upon petition and payment of the fee set forth in § 1.17(i), all the divisions of a reissue will issue simultaneously; if there is any controversy as to one division, the others will be withheld from issue until the controversy is ended, unless the Commissioner orders otherwise.

[60 FR 20227, Apr. 25, 1995]

§ 1.178 Original patent.

The application for a reissue must be accompanied by an offer to surrender the original patent. The application should also be accompanied by the original patent, or if the original is lost or inaccessible, by an affidavit or declaration to that effect. The application may be accepted for examination in the absence of the original patent or the affidavit or declaration, but one or

checked for the presence of an "NRE" entry in the contents. For 09 series reissue applications, the *Official Gazette* publication date appears on the face of the file wrapper. If the filing of the reissue application has not been announced in the *Official Gazette*, the reissue application should be returned to the Office of Initial Patent Examination (Special Processing) to handle the announcement. The examiner should not further act on the reissue until 2 months after announcement of the filing of the reissue has appeared in the *Official Gazette*. See MPEP § 1440 and 37 CFR 1.176.

The examiner should determine if there is concurrent litigation, and if so, the status thereof (MPEP § 1442.01), and whether the reissue file has been appropriately marked. Note MPEP § 1404.

The examiner should determine if a protest has been filed, and if so, it should be handled as set forth in MPEP § 1901.06.

The examiner should determine whether the patent is involved in an interference, and if so, should refer to MPEP § 1449.01 before taking any action on the reissue application.

The examiner should check that an offer to surrender the original patent, or an affidavit or declaration to the effect that the original is lost or inaccessible, has been received. An examination on the merits is made even though the above has not been complied with, but the examiner should require compliance in the first office action. See MPEP § 1416.

The examiner should verify that all Certificate of Correction changes have been properly incorporated into the reissue application. See MPEP § 1411.01.

The examiner should verify that the patent on which the reissue application is based has not expired, either because its term has run or because required maintenance fees have not been paid. Once a patent has expired, the Commissioner no longer has the authority under 35 U.S.C. 251 to reissue the patent. See *In re Morgan*, 990 F.2d 1230, 26 USPQ2d 1392 (Fed. Cir. 1992). See also MPEP § 1415.01.

1444 Review of Reissue Oath/Declaration

In accordance with 37 CFR 1.175, the following is required in the reissue oath/declaration:

(A) A statement that the applicant believes the original patent to be wholly or partly inoperative or invalid—

(1) by reason of a defective specification or drawing, or

(2) by reason of the patentee claiming more or less than patentee had the right to claim in the patent;

(B) A statement of at least one error which is relied upon to support the reissue application, i.e., which provides a basis for the reissue;

(C) A statement that all errors which are being corrected in the reissue application up to the time of filing of the oath/declaration arose without any deceptive intention on the part of the applicant; and

(D) The information required by 37 CFR 1.63.

MPEP § 1414 contains a discussion of each of the above elements (i.e., requirements of a reissue oath/declaration). The examiner should carefully review the reissue oath/declaration in conjunction with that discussion, in order to ensure that each element is provided in the oath/declaration. If the examiner's review of the oath/declaration reveals a lack of compliance with any of the requirements of 37 CFR 1.175, a rejection of all the claims under 35 U.S.C. 251 should be made on the basis that the reissue oath/declaration is insufficient.

In preparing an Office action, the examiner should use form paragraphs 14.01 through 14.01.04 to state the objection(s) to the oath/declaration, i.e., the defects in the oath/declaration. These form paragraphs are reproduced in MPEP § 1414. The examiner should then use form paragraph 14.14 to reject the claims under 35 U.S.C. 251, based upon the improper oath/declaration.

¶ 14.14 Rejection, Defective Reissue Oath or Declaration

Claim [1] rejected as being based upon a defective reissue [2] under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the [3] is set forth in the discussion above in this Office action.

Examiner Note:

1. In bracket 1, list all claims in the reissue application. See MPEP § 706.03(x).
2. This paragraph should be preceded by at least one of the paragraphs 14.01 to 14.01.04.
3. In brackets 2 and 3, insert either --oath-- or --declaration--.

A lack of signature on a reissue oath/declaration would be considered a lack of compliance with 37 CFR 1.175(a) and result in a rejection, including final rejection, of all the claims on the basis that the reissue oath/declaration is insufficient. If the unsigned reissue oath/declaration is submitted as part of a reply which is otherwise properly signed and responsive to the outstanding Office action, the reply should be accepted by the examiner as proper and responsive, and the oath/decla-

tion considered fully in the next Office action. The reply should not be treated as an unsigned or improperly signed amendment (see MPEP § 714.01(a)), nor do the provisions of *Ex Parte Quayle* apply in this situation. The lack of signature, along with any other oath/declaration deficiencies, should be noted in the next Office action *rejecting* the claims as being based upon an insufficient reissue oath/declaration.

HANDLING OF THE REISSUE OATH/DECLARATION DURING THE REISSUE PROCEEDING

An initial reissue oath/declaration is submitted with the reissue application. Where the reissue oath/declaration fails to comply with 37 CFR 1.175(a), the examiner will so notify the applicant in an Office action, rejecting the claims under 35 U.S.C. 251 as discussed above. In reply to the Office action, a supplemental reissue oath/declaration should be submitted dealing with the noted defects in the reissue oath/declaration.

Where the initial reissue oath/declaration (1) failed to provide *any* error statement, or (2) attempted to provide an error statement, but failed to identify any error under 35 U.S.C. 251 upon which reissue can be based (see MPEP § 1402), the examiner should reject all the claims as being based upon a defective reissue oath/declaration under 35 U.S.C. 251. To support the rejection, the examiner should point out the failure of the initial oath/declaration to comply with 37 CFR 1.175 because an error under 35 U.S.C. 251 upon which reissue can be based was not identified therein. In reply to the rejection under 35 U.S.C. 251, a supplemental reissue oath/declaration must be submitted stating an error under 35 U.S.C. 251 which can be relied upon to support the reissue application. Submission of this supplemental reissue oath/declaration to obviate the rejection cannot be deferred by applicant until the application is otherwise in condition for allowance. In this instance, a proper statement of error *was never provided in the initial reissue oath/declaration*, thus a supplemental oath/declaration is required *in reply to the Office action* in order to properly establish grounds for reissue.

A different situation may arise where the initial reissue oath/declaration does properly identify one or more errors under 35 U.S.C. 251 as being the basis for reissue, however, because of changes or amendments made during prosecution, none of the identified errors are relied upon any more. A supplemental oath/declaration will be needed to identify at least one error *now* being relied

upon as the basis for reissue, even though the prior oath/declaration was found proper by the examiner. The supplemental oath/declaration need *not* also indicate that the error(s) identified in the prior oath(s)/declaration(s) is/are no longer being corrected. In this instance, applicant's submission of the supplemental reissue oath/declaration to obviate the rejection under 35 U.S.C. 251 can, at applicant's option, be deferred until the application is otherwise in condition for allowance. The submission can be deferred because a proper statement of error was provided in the initial reissue oath/declaration. Applicant need only request that submission of the supplemental reissue oath/declaration be deferred until allowance, and such a request will be considered a complete reply to the rejection.

SUPPLEMENTAL REISSUE OATH/DECLARATION UNDER 37 CFR 1.175(b)(1):

Once the reissue oath/declaration is found to comply with 37 CFR 1.175(a), it is not required, nor is it suggested, that a new reissue oath/declaration be submitted together with each new amendment and correction of error in the patent. During the prosecution of a reissue application, amendments are often made and additional errors in the patent are corrected. A supplemental oath/declaration need not be submitted with each amendment and additional correction. Rather, it is suggested that the reissue applicant wait until the case is in condition for allowance, and then submit a cumulative supplemental reissue oath/declaration pursuant to 37 CFR 1.175(b)(1).

See MPEP § 1414.01 for a discussion of the required content of a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1).

A supplemental oath/declaration under 37 CFR 1.175(b)(1) must be submitted before allowance. It may be submitted with any reply prior to allowance. It may be submitted to overcome a rejection under 35 U.S.C. 251 made by the examiner, where it is indicated that the submission of the supplemental oath/declaration will overcome the rejection.

A supplemental oath/declaration under 37 CFR 1.175(b)(1) will be required where:

(A) the application is otherwise (other than the need for this supplemental oath/declaration) in condition for allowance;

(B) amendments or other corrections of errors in the patent have been made subsequent to the last oath/declaration filed in the application; and

(C) at least one of the amendments or other corrections corrects an error under 35 U.S.C. 251.

When a supplemental oath/declaration under 37 CFR 1.175(b)(1) directed to the amendments or other corrections of error is required, the examiner is encouraged to telephone the applicant and request the submission of the supplemental oath/declaration by fax. If the circumstances do not permit making a telephone call, or if applicant declines or is unable to promptly submit the oath/declaration, the examiner should issue a final Office action (final rejection) and use form paragraph 14.05.02.

¶ 14.05.02 *Supplemental Oath or Declaration Required Prior to Allowance*

In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed.

Claim [1] rejected as being based upon a defective reissue [2] under 35 U.S.C. 251. See 37 CFR 1.175. The nature of the defect is set forth above.

Receipt of an appropriate supplemental oath/declaration under 37 CFR 1.175(b)(1) will overcome this rejection under 35 U.S.C. 251. An example of acceptable language to be used in the supplemental oath/declaration is as follows:

"Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant."

Examiner Note:

1. In bracket 1, list all claims in the reissue application.
2. In bracket 2, insert either --oath-- or --declaration--.
3. This form paragraph is used in an Office action to: (a) remind applicant of the requirement for submission of the supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) before allowance and (b) at the same time, reject all the claims since the reissue application is defective until the supplemental oath/declaration is submitted.
4. **Do not** use this form paragraph if no amendments (or other corrections of the patent) have been made subsequent to the last oath/declaration filed in the case; instead allow the case.
5. This form paragraph **cannot** be used in an *Ex parte Quayle* action to require the supplemental oath/declaration, because the rejection under 35 U.S.C. 251 is more than a matter of form.
6. **Do not** use this form paragraph in an examiner's amendment. The supplemental oath/declaration **must** be filed prior to mailing of the Notice of Allowability.

As noted above, the examiner will issue a final Office action where the application is otherwise in condition for allowance, and amendments or other corrections of error in the patent have been made subsequent to the last oath/declaration filed in the application. The examiner will be introducing (via form paragraph 14.05.02) a rejection into the case for the first time in the prosecution,

once the claims are determined to be otherwise allowable. This introduction of a new ground of rejection under 35 U.S.C. 251 will not prevent the action from being made final on a second or subsequent action because of the following factors:

(A) The finding of the case in condition for allowance is the first opportunity that the examiner has to make the rejection;

(B) The rejection is being made in reply to, i.e., was caused by, an amendment of the application (to correct errors in the patent);

(C) All applicants are on notice that this rejection will be made upon finding of the case otherwise in condition for allowance where errors have been corrected subsequent to the last oath/declaration filed in the case, therefore, the rejection should have been expected by applicant; and

(D) The rejection will not prevent applicant from exercising any rights as to curing the rejection, since applicant need only submit a supplemental oath/declaration with the above-described language, and it will be entered to cure the rejection.

Where the application is in condition for allowance and **no amendments or other corrections of error in the patent have been made subsequent to the last oath/declaration** filed in the application, a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) **should not be required by the examiner**. Instead, the examiner should issue a Notice of Allowability indicating allowance of the claims.

AFTER ALLOWANCE

Where applicant seeks to correct an error after allowance of the application, any amendment of the patent correcting the error must be submitted in accordance with 37 CFR 1.312. As set forth in 37 CFR 1.312, no amendment may be made as a matter of right in an application after the mailing of the notice of allowance. An amendment filed before the payment of the issue fee may be entered on the recommendation of the primary examiner, approved by the supervisory patent examiner, without withdrawing the case from issue. An amendment filed after the date the issue fee is paid must be accompanied by a petition including the fee set forth in 37 CFR 1.17(i) and a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented. This petition is decided by the Group Director.

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One of ordinary skill in the art upon reviewing the specification and drawings of Appellants' application would clearly be apprised that Appellants' invention is directed to a memory controller which controls the operation of, for example, semiconductor memory. Such is clearly not taught or suggested by Graciotti nor any of the other references of record whether taken individually or in combination with each other.

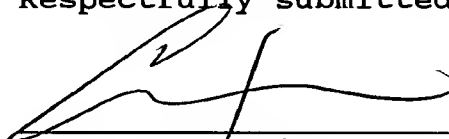
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Respectfully submitted,



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(2) All errors being corrected in the reissue application up to the time of filing of the oath or declaration under this paragraph arose without any deceptive intention on the part of the applicant.

(b)(1) For any error corrected, which is not covered by the oath or declaration submitted under paragraph (a) of this section, applicant must submit a supplemental oath or declaration stating that every such error arose without any deceptive intention on the part of the applicant. Any supplemental oath or declaration required by this paragraph must be submitted before allowance and may be submitted:

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(ii) In order to overcome a rejection under 35 U.S.C. 251 made by the examiner where it is indicated that the submission of a supplemental oath or declaration as required by this paragraph will overcome the rejection.

(2) For any error sought to be corrected after allowance, a supplemental oath or declaration must accompany the requested correction stating that the error(s) to be corrected arose without any deceptive intention on the part of the applicant.

(c) Having once stated an error upon which the reissue is based, as set forth in paragraph (a)(1), unless all errors previously stated in the oath or declaration are no longer being corrected, a subsequent oath or declaration under paragraph (b) of this section need not specifically identify any other error or errors being corrected.

(d) The oath or declaration required by paragraph (a) of this section may be

submitted under the provisions of §1.53(f).

[62 FR 53196, Oct. 10, 1997]

§1.176 Examination of reissue.

An original claim, if re-presented in the reissue application, is subject to re-examination, and the entire application will be examined in the same manner as original applications, subject to the rules relating thereto, excepting that division will not be required. Applications for reissue will be acted on by the examiner in advance of other applications, but not sooner than two months after announcement of the filing of the reissue application has appeared in the *Official Gazette*.

[42 FR 5595, Jan. 28, 1977]

§1.177 Reissue in divisions.

The Commissioner may, in his or her discretion, cause several patents to be issued for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for each division. Each division of a reissue constitutes the subject of a separate specification descriptive of the part or parts of the invention claimed in such division; and the drawing may represent only such part or parts, subject to the provisions of §§1.83 and 1.84. On filing divisional reissue applications, they shall be referred to the Commissioner. Unless otherwise ordered by the Commissioner upon petition and payment of the fee set forth in §1.17(i), all the divisions of a reissue will issue simultaneously; if there is any controversy as to one division, the others will be withheld from issue until the controversy is ended, unless the Commissioner orders otherwise.

[60 FR 20227, Apr. 25, 1995]

§1.178 Original patent.

The application for a reissue must be accompanied by an offer to surrender the original patent. The application should also be accompanied by the original patent, or if the original is lost or inaccessible, by an affidavit or declaration to that effect. The application may be accepted for examination in the absence of the original patent or the affidavit or declaration, but one or

checked for the presence of an "NRE" entry in the contents. For 09 series reissue applications, the *Official Gazette* publication date appears on the face of the file wrapper. If the filing of the reissue application has not been announced in the *Official Gazette*, the reissue application should be returned to the Office of Initial Patent Examination (Special Processing) to handle the announcement. The examiner should not further act on the reissue until 2 months after announcement of the filing of the reissue has appeared in the *Official Gazette*. See MPEP § 1440 and 37 CFR 1.176.

The examiner should determine if there is concurrent litigation, and if so, the status thereof (MPEP § 1442.01), and whether the reissue file has been appropriately marked. Note MPEP § 1404.

The examiner should determine if a protest has been filed, and if so, it should be handled as set forth in MPEP § 1901.06.

The examiner should determine whether the patent is involved in an interference, and if so, should refer to MPEP § 1449.01 before taking any action on the reissue application.

The examiner should check that an offer to surrender the original patent, or an affidavit or declaration to the effect that the original is lost or inaccessible, has been received. An examination on the merits is made even though the above has not been complied with, but the examiner should require compliance in the first office action. See MPEP § 1416.

The examiner should verify that all Certificate of Correction changes have been properly incorporated into the reissue application. See MPEP § 1411.01.

The examiner should verify that the patent on which the reissue application is based has not expired, either because its term has run or because required maintenance fees have not been paid. Once a patent has expired, the Commissioner no longer has the authority under 35 U.S.C. 251 to reissue the patent. See *In re Morgan*, 990 F.2d 1230, 26 USPQ2d 1392 (Fed. Cir. 1992). See also MPEP § 1415.01.

1444 Review of Reissue Oath/Declaration

In accordance with 37 CFR 1.175, the following is required in the reissue oath/declaration:

(A) A statement that the applicant believes the original patent to be wholly or partly inoperative or invalid—

(1) by reason of a defective specification or drawing, or

(2) by reason of the patentee claiming more or less than patentee had the right to claim in the patent;

(B) A statement of at least one error which is relied upon to support the reissue application, i.e., which provides a basis for the reissue;

(C) A statement that all errors which are being corrected in the reissue application up to the time of filing of the oath/declaration arose without any deceptive intention on the part of the applicant; and

(D) The information required by 37 CFR 1.63.

MPEP § 1414 contains a discussion of each of the above elements (i.e., requirements of a reissue oath/declaration). The examiner should carefully review the reissue oath/declaration in conjunction with that discussion, in order to ensure that each element is provided in the oath/declaration. If the examiner's review of the oath/declaration reveals a lack of compliance with any of the requirements of 37 CFR 1.175, a rejection of all the claims under 35 U.S.C. 251 should be made on the basis that the reissue oath/declaration is insufficient.

In preparing an Office action, the examiner should use form paragraphs 14.01 through 14.01.04 to state the objection(s) to the oath/declaration, i.e., the defects in the oath/declaration. These form paragraphs are reproduced in MPEP § 1414. The examiner should then use form paragraph 14.14 to reject the claims under 35 U.S.C. 251, based upon the improper oath/declaration.

¶ 14.14 Rejection, Defective Reissue Oath or Declaration

Claim [1] rejected as being based upon a defective reissue [2] under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the [3] is set forth in the discussion above in this Office action.

Examiner Note:

1. In bracket 1, list all claims in the reissue application. See MPEP § 706.03(x).
2. This paragraph should be preceded by at least one of the paragraphs 14.01 to 14.01.04.
3. In brackets 2 and 3, insert either --oath-- or --declaration--.

A lack of signature on a reissue oath/declaration would be considered a lack of compliance with 37 CFR 1.175(a) and result in a rejection, including final rejection, of all the claims on the basis that the reissue oath/declaration is insufficient. If the unsigned reissue oath/declaration is submitted as part of a reply which is otherwise properly signed and responsive to the outstanding Office action, the reply should be accepted by the examiner as proper and responsive, and the oath/decla-

tion considered fully in the next Office action. The reply should not be treated as an unsigned or improperly signed amendment (see MPEP § 714.01(a)), nor do the provisions of *Ex Parte Quayle* apply in this situation. The lack of signature, along with any other oath/declaration deficiencies, should be noted in the next Office action *rejecting* the claims as being based upon an insufficient reissue oath/declaration.

HANDLING OF THE REISSUE OATH/DECLARATION DURING THE REISSUE PROCEEDING

An initial reissue oath/declaration is submitted with the reissue application. Where the reissue oath/declaration fails to comply with 37 CFR 1.175(a), the examiner will so notify the applicant in an Office action, rejecting the claims under 35 U.S.C. 251 as discussed above. In reply to the Office action, a supplemental reissue oath/declaration should be submitted dealing with the noted defects in the reissue oath/declaration.

Where the initial reissue oath/declaration (1) failed to provide *any* error statement, or (2) attempted to provide an error statement, but failed to identify any error under 35 U.S.C. 251 upon which reissue can be based (see MPEP § 1402), the examiner should reject all the claims as being based upon a defective reissue oath/declaration under 35 U.S.C. 251. To support the rejection, the examiner should point out the failure of the initial oath/declaration to comply with 37 CFR 1.175 because an error under 35 U.S.C. 251 upon which reissue can be based was not identified therein. In reply to the rejection under 35 U.S.C. 251, a supplemental reissue oath/declaration must be submitted stating an error under 35 U.S.C. 251 which can be relied upon to support the reissue application. Submission of this supplemental reissue oath/declaration to obviate the rejection cannot be deferred by applicant until the application is otherwise in condition for allowance. In this instance, a proper statement of error *was never provided in the initial reissue oath/declaration*, thus a supplemental oath/declaration is required *in reply to the Office action* in order to properly establish grounds for reissue.

A different situation may arise where the initial reissue oath/declaration does properly identify one or more errors under 35 U.S.C. 251 as being the basis for reissue, however, because of changes or amendments made during prosecution, none of the identified errors are relied upon any more. A supplemental oath/declaration will be needed to identify at least one error *now* being relied

upon as the basis for reissue, even though the prior oath/declaration was found proper by the examiner. The supplemental oath/declaration need *not* also indicate that the error(s) identified in the prior oath(s)/declaration(s) is/are no longer being corrected. In this instance, applicant's submission of the supplemental reissue oath/declaration to obviate the rejection under 35 U.S.C. 251 can, at applicant's option, be deferred until the application is otherwise in condition for allowance. The submission can be deferred because a proper statement of error was provided in the initial reissue oath/declaration. Applicant need only request that submission of the supplemental reissue oath/declaration be deferred until allowance, and such a request will be considered a complete reply to the rejection.

SUPPLEMENTAL REISSUE OATH/DECLARATION UNDER 37 CFR 1.175(b)(1):

Once the reissue oath/declaration is found to comply with 37 CFR 1.175(a), it is not required, nor is it suggested, that a new reissue oath/declaration be submitted together with each new amendment and correction of error in the patent. During the prosecution of a reissue application, amendments are often made and additional errors in the patent are corrected. A supplemental oath/declaration need not be submitted with each amendment and additional correction. Rather, it is suggested that the reissue applicant wait until the case is in condition for allowance, and then submit a cumulative supplemental reissue oath/declaration pursuant to 37 CFR 1.175(b)(1).

See MPEP § 1414.01 for a discussion of the required content of a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1).

A supplemental oath/declaration under 37 CFR 1.175(b)(1) must be submitted before allowance. It may be submitted with any reply prior to allowance. It may be submitted to overcome a rejection under 35 U.S.C. 251 made by the examiner, where it is indicated that the submission of the supplemental oath/declaration will overcome the rejection.

A supplemental oath/declaration under 37 CFR 1.175(b)(1) will be required where:

(A) the application is otherwise (other than the need for this supplemental oath/declaration) in condition for allowance;

(B) amendments or other corrections of errors in the patent have been made subsequent to the last oath/declaration filed in the application; and

(C) at least one of the amendments or other corrections corrects an error under 35 U.S.C. 251.

When a supplemental oath/declaration under 37 CFR 1.175(b)(1) directed to the amendments or other corrections of error is required, the examiner is encouraged to telephone the applicant and request the submission of the supplemental oath/declaration by fax. If the circumstances do not permit making a telephone call, or if applicant declines or is unable to promptly submit the oath/declaration, the examiner should issue a final Office action (final rejection) and use form paragraph 14.05.02.

¶ 14.05.02 *Supplemental Oath or Declaration Required Prior to Allowance*

In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed.

Claim [1] rejected as being based upon a defective reissue [2] under 35 U.S.C. 251. See 37 CFR 1.175. The nature of the defect is set forth above.

Receipt of an appropriate supplemental oath/declaration under 37 CFR 1.175(b)(1) will overcome this rejection under 35 U.S.C. 251. An example of acceptable language to be used in the supplemental oath/declaration is as follows:

"Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant."

Examiner Note:

1. In bracket 1, list all claims in the reissue application.
2. In bracket 2, insert either --oath-- or --declaration--.
3. This form paragraph is used in an Office action to: (a) remind applicant of the requirement for submission of the supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) before allowance and (b) at the same time, reject all the claims since the reissue application is defective until the supplemental oath/declaration is submitted.
4. **Do not** use this form paragraph if no amendments (or other corrections of the patent) have been made subsequent to the last oath/declaration filed in the case; instead allow the case.
5. This form paragraph **cannot** be used in an *Ex parte Quayle* action to require the supplemental oath/declaration, because the rejection under 35 U.S.C. 251 is more than a matter of form.
6. **Do not** use this form paragraph in an examiner's amendment. The supplemental oath/declaration **must** be filed prior to mailing of the Notice of Allowability.

As noted above, the examiner will issue a final Office action where the application is otherwise in condition for allowance, and amendments or other corrections of error in the patent have been made subsequent to the last oath/declaration filed in the application. The examiner will be introducing (via form paragraph 14.05.02) a rejection into the case for the first time in the prosecution,

once the claims are determined to be otherwise allowable. This introduction of a new ground of rejection under 35 U.S.C. 251 will not prevent the action from being made final on a second or subsequent action because of the following factors:

(A) The finding of the case in condition for allowance is the first opportunity that the examiner has to make the rejection;

(B) The rejection is being made in reply to, i.e., was caused by, an amendment of the application (to correct errors in the patent);

(C) All applicants are on notice that this rejection will be made upon finding of the case otherwise in condition for allowance where errors have been corrected subsequent to the last oath/declaration filed in the case, therefore, the rejection should have been expected by applicant; and

(D) The rejection will not prevent applicant from exercising any rights as to curing the rejection, since applicant need only submit a supplemental oath/declaration with the above-described language, and it will be entered to cure the rejection.

Where the application is in condition for allowance and **no amendments or other corrections of error in the patent have been made subsequent to the last oath/declaration** filed in the application, a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) **should not be required by the examiner**. Instead, the examiner should issue a Notice of Allowability indicating allowance of the claims.

AFTER ALLOWANCE

Where applicant seeks to correct an error after allowance of the application, any amendment of the patent correcting the error must be submitted in accordance with 37 CFR 1.312. As set forth in 37 CFR 1.312, no amendment may be made as a matter of right in an application after the mailing of the notice of allowance. An amendment filed before the payment of the issue fee may be entered on the recommendation of the primary examiner, approved by the supervisory patent examiner, without withdrawing the case from issue. An amendment filed after the date the issue fee is paid must be accompanied by a petition including the fee set forth in 37 CFR 1.17(i) and a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented. This petition is decided by the Group Director.